

REMARKS

Applicant wishes to thank the Examiner for the consideration given this case to date. Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the application, as amended, is now in condition for allowance. As examined, Claims 1-7 and 9-14 were pending. As amended, Claims 1-7 and 9-12, 15 and 16 are pending.

THE EXAMINER'S ACTION

In the Office Action, the Examiner:

- 1) rejected claim 12 under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 4,484,574 to DeRusha et. al. ("DeRusha");
- 2) rejected claims 1-3, 5, 7, 9, 10 and 14 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 3,895,153 to Johnston et al. ("Johnston");
- 3) rejected claims 12 and 13 under 35 U.S.C. § 103(a), as being anticipated by U.S. Patent No. 4,248,762 to Hornibrook et al. ("Hornibrook");
- 4) rejected claims 1-6, and 9-11 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 5,508,084 to Reeves et al. ("Reeves") in view of U.S. Patent No. 4,343,856 to Goswami et al. ("Goswami").

REJECTIONS UNDER 35 U.S.C. § 102(b)

The Office maintains that DeRusha anticipates claim 12. Office Action, p. 2. However, with the amendments to claim 12 herein, substantially incorporating independent claim 13, the rejection is believed moot. Arguments directed at the combination will be addressed below in connection with the obviousness rejection of claim 13.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The obviousness rejections are believed overcome by amendment or argument as more specifically outlined below under headings of the primary reference applied.

Johnston

The Office has maintained the rejections of claims 1-3, 5, 7, 9 and 10 and has rejected the newly added claim 14 under Johnston , Office Action, p. 3 and 11. The amendments above substantially incorporate the limitations of dependent claim 14 into claim 1.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in KSR, 550 U.S. at 418.

With respect to claim 1 now incorporating the limitations of claim 14, the Office concedes that Johnston fails to disclose a peel adhesion of greater than 2.0 lb/in under the PSTC-101 method as modified. To overcome the admitted failure in support of the obviousness rejection, the Office states in conclusory fashion that "it would be obvious to one having ordinary skill in the art that the adhesive product would meet the peel adhesion when peeling the tape at a 90 degree angle after application to a stainless steel panel." Office Action, p. 12.

In addition to the lack of articulated reasoning underpinning the obviousness rejection, the Office doesn't even acknowledge that Johnston is completely silent on peel adhesion values and test methodologies. Johnston includes no discussion of peel adhesion values, peel angles or dwell times - all of which can materially affect peel adhesion. Mausar Declaration filed with "Amendment C and Response to Office Action" on 23 February 2011 (hereafter, "Mauser Decl."), ¶ 23, 51, 55, 56.

Because a *prima facie* of obviousness has not been established for defendant claim 14, its incorporation into claim 1 is believed patentable over the references of record.

Hornibrook

The Office has maintained the rejections of claim 12 and has rejected the newly added claim 13 under Hornibrook, Office Action, p. 5 and 10. The

amendments above substantially incorporate the limitations of dependent claim 13 into independent claim 12.

With respect to claim 12, the Office asserts that Hornibrook teaches a thickness of 0.002 to 0.020 inches. Office Action, p. 10. The disclosed range is described generally at column 2, lines 1-15 (hereafter referred to as the "Column 2 Disclosure"). The Office also asserts that Hornibrook teaches a peel adhesion of 7.5 pounds per linear inch. Office Action, p. 10. The peel adhesion is said to be described at column 5, lines 1-3 (hereafter, the "Example 1 Disclosure").

Significantly, the Column 2 Disclosure cited to show the claimed range includes no description of peel adhesion. The Example 1 Disclosure cited to show the peel adhesion refers to a thickness well under the claimed range. Specifically, the Example 1 Disclosure teaches a 0.008 inch PVC film (column 4, line 33) and a 0.0012 inch adhesive (column 4, line 52). In other words, Hornibrook fails to teach the claimed combination of peel adhesion and thickness.

Regarding claim 12 as amended, the Office concedes that Hornibrook fails to disclose that the peel adhesion is measured under a test method including peeling the tape at a 90 degree angle after application to a stainless steel panel. Office Action, p. 11. To overcome the failure in support of the obviousness rejection, the Office notes that:

"Hornibrook et al. disclose[s] where the adhesive tape has a peel adhesion of 7.5 pounds per linear inch (the Example 1 Disclosure), which meets the limitations of a peel adhesion greater than 2.0 lb/in width []. Since Hornibrook et al. disclose the adhesive product made of the desired materials with the specific dimensions, it would be obvious to one having ordinary skill in the art that the adhesive product would meet the peel adhesion when peeling the tape at a 90 degree angle after application to a stainless steel panel."

Office Action, p. 11 (parenthetical and emphasis provided).

Notably, the support for the obviousness conclusion relies (incorrectly) on the improper "cherry-picking" disclosures from divergent parts of the Hornibrook description, namely the Example 1 Disclosure on the one hand and the "specific

dimensions" likely referring to the thickness range only taught in the Column 2 Disclosure on the other hand.

Hornibrook also describes a different test methodology. Specifically, Hornibrook in general, and the Example 1 Disclosure in particular describe a 180° peel angle and a 24 hour wetout or dwell. See, eg., Column 4, line 67 bridging to column 5, line 1; and Mausar Decl. ¶ 48-50. Differently, claim 12 calls for a 90° peel angle, and different peel angles result in different adhesion ratings. Mausar Decl. ¶ 23, 51. Indeed, Declarant Mausar states, "I do not believe that a skilled artisan would interpret the results of ... Hornibrook to be equivalent to the results of ... the applicant." Mausar Decl. ¶ 55.

For each of these reasons alone, and more powerfully combined, the fair teachings of Hornibrook provide no rational underpinning for the conclusion that the amended claim 12 is obvious in light of the prior art.

Reeves

The Office has rejected claims 1-6, 9-11 under Reeves in view of Goswami, Office Action, p. 7. As noted above, the amendments herein substantially incorporate the limitations of dependent claim 14 into independent claim 1 and thus, the rejection is believed moot as to claim 1 and dependant claims 2-6 and 9-10 for at least the reason that the Reeves combination was not applied to claim 14.

As to claim 11, the combination is improper. As set forth in "Amendment C and Response to Office Action" filed by applicant on 23 February 2011, the Reeves reference is not only inoperable in its teaching of Shore A hardness ranges, it is unintelligible. Mausar Decl. ¶ 46.

Because of this ambiguity of the entire range, the Reeves reference may not be used for any teaching, "overlapping" or otherwise, of hardness ranges, although it may be used for its other, enabled teachings. Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989), citing, In re Payne, 606 F.2d 303, 314, (CCPA 1979).

Assuming for argument's sake, that Reeves is enabled and teaches a polyvinyl chloride layer (Office Action, p. 8 citing Column 14, lines 10-12) among other limitations, in order to remedy the defect in the Shore A ranges, the Office looks to Goswami.

The Office contends that Goswami teaches a polyvinyl chloride layer having a Shore A hardness of 80 to 95. Office Action, p. 8. However, a close reading of the cited passage reveals that Goswami does not describe such a polymer. Rather, Goswami desires such a vinyl film without describing how to achieve it. Specifically, the cited passage reads:

"The internally plasticized resin suitable for use in the present invention should have a Tg of from about - 10° C. to about 30° C. and should give a vinyl film having a Shore "A" Hardness of about 80 to about 95 when in the absence of functional additives and when no substantial amounts of plasticizer are present."

Goswami, Column 2, lines 15-20 (emphasis supplied).

Other passages and examples in Goswami are silent on the achieved Shore A hardness values obtained. Thus, the only mention of Shore values in Goswami, refers only to a hoped for feature with no information about how to achieve the result.

Both references, Reeves and Goswami, fail to teach or suggest the missing Shore A hardness teachings. For this reason alone, the rejection is improper for failing to establish a *prima facie* case of obviousness.

CONCLUSION

Applicant, intending to be completely responsive, believes that the amendments and remarks presented above resolve all outstanding issues on the above-referenced application. Accordingly, the application is believed to be in condition for allowance. Early notice thereof is earnestly solicited. While no additional fees are believed due, the Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 50-4883, referencing Attorney Docket No. 5923.0001.

Respectfully submitted,

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